

ESTTA Tracking number: **ESTTA138324**

Filing date: **05/01/2007**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Nationstar Mortgage LLC
Granted to Date of previous extension	05/02/2007
Address	2828 North Harwood Street, 11th Floor Dallas, TX 75201 UNITED STATES
Attorney information	Bryce J. Maynard Buchanan Ingersoll & Rooney PC 1737 King Street Suite 500 Alexandria, VA 22314 UNITED STATES bryce.maynard@bipc.com Phone:703-836-6620

Applicant Information

Application No	78866376	Publication date	01/02/2007
Opposition Filing Date	05/01/2007	Opposition Period Ends	05/02/2007
Applicant	Ahmad, Mujahid # 102 2001 North Daniel Street Arlington, VA 22201 UNITED STATES		

Goods/Services Affected by Opposition

Class 036. First Use: 2005/04/04 First Use In Commerce: 2005/04/04
All goods and services in the class are opposed, namely: Real estate brokerage; rental of real estate; real estate management services, namely, management of commercial and residential properties; real estate investment; residential and commercial property and insurance brokerage; mortgage brokerage; and business finance procurement services

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)

Marks Cited by Opposer as Basis for Opposition

U.S. Application No.	78871883	Application Date	04/28/2006
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	NATIONSTAR MORTGAGE
Design Mark	
Description of Mark	NONE
Goods/Services	Class 036. First use: Mortgage lending services

U.S. Application No.	78872148	Application Date	04/28/2006
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	NATIONSTAR MORTGAGE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: Mortgage lending services		

Attachments	78871883#TMSN.jpeg (1 page)(bytes) 78872148#TMSN.jpeg (1 page)(bytes) notice_of_opposition_NATIONSTAR.pdf (7 pages)(29641 bytes)
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Signature	/Bryce J. Maynard/
Name	Bryce J. Maynard
Date	05/01/2007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

RE: U.S. Trademark Application Serial No. 78/866,376
Published in the *Official Gazette* on January 2, 2007

NATIONSTAR MORTGAGE LLC,)	
)	
Opposer,)	
)	Opposition No. _____
-v-)	
)	
MUJAHID AHMAD,)	
)	
Applicant.)	
)	
Attorney Docket No. 0055673-000033)	
_____)	

NOTICE OF OPPOSITION

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

Commissioner:

In the matter of U.S. Trademark Application Serial No. 78/866,376, filed on April 20, 2006 by Mujahid Ahmad (“Applicant”), to register the mark NATIONSTAR (“Applicant’s NATIONSTAR Mark”) in connection with “real estate brokerage; rental of real estate; real estate management services, namely, management of commercial and residential properties; real estate investment; residential and commercial property and insurance brokerage; mortgage brokerage; and business

finance procurement services” in International Class 36 (“Applicant’s Services”), and published in the *Official Gazette* on January 2, 2007, Nationstar Mortgage LLC (“Opposer”) believes that it will be damaged by registration of Applicant’s NATIONSTAR Mark and hereby opposes same. The grounds for this opposition are as follows:

1. Applicant is the record owner of Application Serial No. 78/866,376 for the mark NATIONSTAR for Applicant’s Services.

2. Opposer is a limited liability company organized under the laws of the State of North Carolina, located and doing business at 2828 North Harwood Street, 11th Floor, Dallas, Texas 75201.

3. Opposer is the owner of U.S. Application Serial No. 78/872,148 for the mark NATIONSTAR MORTGAGE and Design and U.S. Application Serial No. 78/871,883 for the mark NATIONSTAR MORTGAGE, both of which cover “mortgage lending services” (“Opposer’s Services”), and both of which were filed on April 28, 2006. These applications are hereinafter collectively referred to as “Opposer’s NATIONSTAR MORTGAGE Marks.”

Count I: Fraud In The Application

A. Fraudulent Allegation of Use in Commerce

4. Applicant’s application contains the statements that “[t]he applicant ... is using the mark in commerce,” and that “the mark was first used at least as early as 04/04/2005, and first used in commerce at least as early as 04/04/2005, and is now in use in such commerce.” The application also contains a standard declaration as to the truth of applicant’s statements in the application.

5. Upon information and belief, Applicant did not use Applicant’s NATIONSTAR Mark in connection with Applicant’s Services in commerce on or anytime prior to April 20, 2006, the

filing date of Applicant's NATIONSTAR Mark. Upon information and belief, Applicant has not used Applicant's NATIONSTAR Mark in connection with Applicant's Services in interstate commerce in the United States.

6. Upon information and belief, the alleged April 4, 2005 dates of first use and first use in commerce listed by Applicant in Application Serial No. 78/866,376 are based on nothing more than Applicant's registration of the domain names "nationstarmortgage.com" and "nationstarmortgage.net."

7. Upon information and belief, any company or individual providing mortgage services must be registered in every state in which such services are offered. Upon information and belief, Applicant is not registered to provide mortgage services in any state. Therefore, any alleged use of the NATIONSTAR Mark in connection with Applicant's Services is fraudulent/

8. Upon information and belief, Applicant made the false statements as to the use of his mark in commerce and the first use dates of that mark with the intent to procure a registration to which Applicant was not entitled, and Applicant was successful in procuring favorable examination, allowance, and publication of the application.

9. Upon information and belief, Applicant's false statements were made knowingly. Applicant made knowing false statements as to the use of his mark in commerce and the first use dates of that mark with the intent to procure a registration to which Applicant was not entitled, and Applicant was successful in procuring favorable examination, allowance, and publication of the application.

B. Fraudulent Specimen of Use

10. Applicant did not file a specimen of use with the original application on April 20, 2006. After receiving an office action requiring submission of a specimen, Applicant submitted an alleged specimen of use on October 19, 2006. The alleged specimen consisted of a printout that displayed the NATIONSTAR MORTGAGE mark in connection with the alleged offering of mortgage services.¹ The response submitted on October 19, 2006 also contained a signed declaration stating that “the specimen was in use in commerce at least as early as the filing date of the application” and that statements in the declaration were true.

11. Upon information and belief, the alleged specimen of use filed on October 19, 2006 was not in use in commerce at least as early as April 20, 2006, the filing date of Application Serial No. 78/866,376.

12. Upon information and belief, Applicant made the false statements as to the use of the specimen with the intent to procure a registration to which Applicant was not entitled, and Applicant was successful in procuring favorable examination, allowance, and publication of the application.

13. Upon information and belief, Applicant’s false statements were made knowingly. Applicant made knowing false statements as to the use of the specimen with the intent to procure a registration to which Applicant was not entitled, and Applicant was successful in procuring favorable examination, allowance, and publication of the application.

Count II: Invalid Application - No Use in Commerce

14. Opposer repeats and realleges paragraphs 1 through 13 above.

¹ Applicant’s email address displayed twice in the specimen submitted to the Examiner contains the term and registered service mark “Realtor”®. Upon information and belief, Applicant is neither a Realtor ® agent, a member of the National Association of Realtors, nor licensed to use that registered mark.

15. Applicant's Application Serial No. 78/866,376 was filed and was approved and published based solely on alleged actual use of Applicant's NATIONSTAR Mark in commerce. Upon information and belief, Applicant had not made such use in commerce at any time prior to or on the filing date of the application. Applicant's application is void and invalid for lack of a filing basis.

16. In the alternative, upon information and belief, even if Applicant had made any use in commerce of Applicant's NATIONSTAR Mark prior to or on the filing date of the application, such use was unlawful as not in compliance with applicable laws and regulations. Applicant's application is void and invalid for lack of lawful use to support the sole filing basis.

Count III: Likelihood of Confusion

17. Opposer repeats and realleges paragraphs 1 through 15 above.

18. Opposer began making bona fide preparations to use Opposer's NATIONSTAR MORTGAGE Marks in commerce prior to the April 20, 2006 filing date of Application Serial No. 78/866,376.

19. Opposer's counsel wrote to Applicant on April 11, 2006, offering to purchase the domain names "nationstarmortgage.com" and "nationstarmortgage.net," which Applicant had registered on April 5, 2005. Opposer's counsel sent a follow-up letter on April 18, 2006.

20. Upon information and belief, Applicant filed Application Serial No. 78/866,376 on April 20, 2006 only upon learning of Opposer's prior preparations to use Opposer's NATIONSTAR MORTGAGE Marks and of Opposer's intention to file applications for Opposer's NATIONSTAR MORTGAGE Marks.

21. Upon information and belief, Applicant had not used Applicant's NATIONSTAR Mark in interstate commerce and did not have a bona fide intent to use Applicant's NATIONSTAR Mark in interstate commerce on the April 20, 2006 filing date of Application Serial No. 78/866,376.

22. Opposer has rights in Opposer's NATIONSTAR MORTGAGE Marks which are prior and superior to any rights that Applicant may have in Applicant's NATIONSTAR Mark.

23. Applicant's NATIONSTAR Mark in Application Serial No. 78/866,376 is highly similar to Opposer's NATIONSTAR MORTGAGE Marks in sight, sound, and commercial impression. In Applicant's alleged specimen of use, the NATIONSTAR Mark is displayed in close proximity to the phrase MORTGAGE, INC., increasing the likelihood that consumers will confuse Applicant's NATIONSTAR Mark with Opposer's NATIONSTAR MORTGAGE Marks.

24. Applicant's Services and Opposer's Services are closely related and are sold or will be sold to identical or highly similar types of consumers through identical or highly similar channels of trade.

25. Applicant's NATIONSTAR Mark in Application Serial No. 78/866,376 so resembles Opposer's NATIONSTAR Mortgage Marks, in which Opposer has prior and superior rights, as to be likely, when applied to Applicant's Services, to cause confusion, to cause mistake, or to deceive, by creating the erroneous impression that Applicant's Services originate from or are associated with Opposer, or that Applicant's Services are authorized, endorsed or sponsored by Opposer.

26. Applicant's filing of Application Serial No. 78/866,376 for Applicant's NATIONSTAR Mark is without license, authorization or permission from Opposer.

27. The granting of a trademark registration for Applicant's NATIONSTAR Mark would violate and diminish the prior and superior rights of Opposer in Opposer's NATIONSTAR MORTGAGE Marks and would be in violation of 15 U.S.C. § § 1052(d).

28. Opposer would be damaged if Application Serial No. 78/866,376 is allowed to register because Applicant will obtain statutory rights in Applicant's NATIONSTAR Mark in violation and derogation of the prior and superior rights of Opposer in Opposer's NATIONSTAR MORTGAGE Marks.

WHEREFORE, Opposer requests that its Opposition be sustained, that Application Serial No. 78/866,376 be rejected and that the registration of NATIONSTAR as a trademark to Applicant be refused, and for such other relief as may be deemed just and proper.

Respectfully submitted,

NATIONSTAR MORTGAGE LLC

Date: May 1, 2007

/Bryce J. Maynard/
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